



AEG150.01CP1C1

PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Vadim R. Viviani et al.  
Appl. No. : 09/993,874  
Filed : November 14, 2001  
For : NUCLEIC ACID MOLECULES  
ENCODING RED AND GREEN  
EMITTING LUCIFERASES  
Examiner : ELIZABETH SLOBODYANSKY  
Group Art Unit : 1652

## CERTIFICATE OF MAILING

I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on

September 14, 2004

(Date)

Katsuhiro Arai, Reg. No. 43,315

RESPONSE TO ADVISORY ACTION

OR to  
acted  
9/30/04  
ES

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This is in response to the Advisory Action mailed August 5, 2004 in the above-identified application. Please reconsider the present application in light of the comments below.

In the Advisory Action, the Examiner asserted:

"[W]hen a new term [is] introduced by the amendment, particularly the one without clear definition, it must have support in the specification. Applicants' arguments appear to be contradictory because there is no need to indicate that a maximum is at approximately 549 nm if one of skill in the art would understand that 'a maximum of 549 nm' means 'a maximum of approximately 549 nm'."

However, the Examiner fails to consider the entire disclosure of the specification including the figures. As discussed below, there is clear support in Fig. 3 which shows a peak at "approximately" 549 nm. Further, the peak was measured with a particular apparatus and it is well known that the use of a different model or different type of apparatus may provide a slight deviation from the peak indicated in Fig. 3. Additionally, although one of skill in the art would understand that "a maximum of 549 nm" means "a maximum of approximately 549 nm", for the clarification purpose, such clarifying amendment to the claim should be allowed.